

### **REMARKS**

Reconsideration of this application is respectfully requested in view of the foregoing amendment and the following remarks.

By the foregoing amendment, claims 1-3, 5-6, and 9-10 have been amended, and claim 4 has been cancelled. Thus, claims 1-3, and 5-12 are currently pending in the application and subject to examination.

In the Office Action mailed January 9, 2006, the Examiner rejected claims 1-3 and 5-12 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,320,909 to Takabatake et al. ("Takabatake") in view of U.S. Patent No. 6,424,381 to Mendenhall et al. ("Mendenhall"). To the extent that the rejections remain applicable to the claims currently pending, the Applicant hereby traverses the rejection, as follows.

The Applicants' invention, as now set forth in claim 1, is directed to an MPEG video decoder or decoding method for an MPEG bit stream into which a plurality of pictures and a plurality of parameters of each layer are encoded comprising first parameters for displaying a first picture and second parameters for displaying a second picture, wherein the first parameters and the second parameters include an identical parameter of the sequence layer

The Applicants submit that Takabatake does not disclose or suggest an MPEG video decoder into which a plurality of pictures and a plurality of parameters of each layer are encoded comprising first parameters for displaying a first picture and second parameters for displaying a second picture, wherein the first parameters and the second parameters include an identical parameter of the sequence layer, as claimed in amended claims 1 and 9. Mendenhall does not cure the deficiency in Takabatake.

Therefore, the Applicants submit that claims 1 and 9, as amended, are allowable over the cited art, for at least this reason.

Claims 2-3, 5-8, and 10-12 depend from claims 1 and 9 and include further limitations. As claims 1 and 9 are allowable, the Applicants submit that claims 2-3, 5-8, and 10-12, which depend from claims 1 and 9 are likewise allowable.

With regard to each of the rejections under §103 in the Office Action, it is also respectfully submitted that the Examiner has not yet set forth a *prima facie* case of obviousness. The PTO has the burden under §103 to establish a *prima facie* case of obviousness. In re Fine, 5 U.S.P.Q.2nd 1596, 1598 (Fed. Cir. 1988). Both the case law of the Federal Circuit and the PTO itself have made clear that where a modification must be made to the prior art to reject or invalidate a claim under §103, there must be a showing of proper motivation to do so. The mere fact that a prior art reference could arguably be modified to meet the claim is insufficient to establish obviousness. The PTO can satisfy this burden only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references. Id. In order to establish obviousness, there must be a suggestion or motivation in the reference to do so. See also In re Gordon, 221 U.S.P.Q. 1125, 1127 (Fed. Cir. 1984) (prior art could not be turned upside down without motivation to do so); In re Rouffet, 149 F.3d 1350 (Fed. Cir. 1998); In re Dembiczak, 175 F.3d 994 (Fed. Cir. 1999); In re Lee, 277 F.3d 1338 (Fed. Cir. 2002).

In the Office Action, the Examiner merely states that the present invention is obvious in light of the cited references. See, e.g., Office Action at page 4. This is an insufficient showing of motivation.

**CONCLUSION**

For all of the above reasons, it is respectfully submitted that the claims now pending patentability distinguish the present invention from the cited references. Accordingly, reconsideration and withdrawal of the outstanding rejections and an issuance of a Notice of Allowance are earnestly solicited.

Should the Examiner determine that any further action is necessary to place this application into better form, the Examiner is encouraged to telephone the undersigned representative at the number listed below.

In the event this paper is not considered to be timely filed, the Applicants hereby petition for an appropriate extension of time. The fee for this extension may be charged to our Deposit Account No. 01-2300. The Commissioner is hereby authorized to charge any fee deficiency or credit any overpayment associated with this communication to Deposit Account No. 01-2300, with reference to Attorney Docket No. 108391-00014.

Respectfully submitted,

Arent Fox PLLC

A handwritten signature in black ink, appearing to read 'Charles M. Marmelstein', is written over the printed name.

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